

REMARKS

Claims 1-3, 5-8, 10-11, 13-16, 18-28, and 30-31 are amended, no claims are canceled, and no claims are added; as a result, claims 1-31 remain pending in this application.

No new matter has been added through the amendments to claims 1-3, 5-8, 10-11, 13-16, 18-28, and 30-31. Support for the amendments to claims 1 and 2 may be found for example, but not limited to, the specification on page 4 at lines 10-14 and on page 11, line 21 through page 12, line 18. Support for the addition of the word "protocol" in claims 3, 8, 11, 16, 20, 24, and 28 may be found for example, but not limited to, the specification on page 4 at lines 4-7.

Claim 5 was amended in order to provide proper antecedent relationship to claim 1 from which claim 5 depends, and to delete subject matter now included in claim 1. Similar amendments were made in claim 30 with respect to claim 26, from which claim 30 depends. Claim 6 was amended in order to provide proper antecedent relationship to claim 2 from which claim 6 depends, and to delete subject matter now included in claim 2. Similar amendments were made in claim 31 with respect to claim 27, from which claim 31 depends.

Support for the amendments to claim 7 and to claim 14 may be found for example, but not limited to, the specification on page 9 at line 24 through page 10, line 2, and in FIG. 2B. Support for the amendments to claim 10, and further support for the amendments to claim 14, may be found for example, but not limited to, the specification on page 7 at lines 1-5, and in FIG. 2A. Claims 13 and 15 were amended merely to clarify the language of the claims.

Claims 18-25 are amended to add the phrase "machine-readable medium" to, and to delete the phrase "signal-bearing media" from, the preambles in each of claims 18-25. Support for this amendment to claims 18-25 may be found for example, but not limited to, the specification on page 11 at lines 4-19. Further support for the amendments to claim 18 may be found for example, but not limited to, the specification on page 4 at lines 10-14 and on page 11, line 21 through page 12, line 18. Further support for the amendments to claim 22 may be found for example, but not limited to, the specification on page 4 at lines 10-19.

Clarification Regarding the Office Action Summary

As stated above, Applicant submits that claims 1-31 are pending in the application. In addition, the Final Office Action on page 2 at item number one states, "Claims 1-31 are still

pending for examination." However, the Office Action Summary at checkbox 4 states, "Claim(s) 1-30 is/are pending in the application." Further, the Office Action Summary at checkbox 6 states, "Claim(s) 1-30 is/are rejected." Applicant has proceeded under the assumption that the statements in the Office Action Summary as quoted above are incorrect, and that claims 1-31 are pending and are rejected. If this assumption is incorrect, Applicant respectfully requests correction/clarification, and reserves the right to respond to any correction or clarification that may be provided in a future official communication with respect to the issue of the currently pending claims in the application.

§112 Rejection of the Claims

Claims 1-3, 7, 10, 14, 18, 22, and 26-27 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness.

Applicant has amended claims 1-3, 7, 10, 14, 18, 22, and 26-27 in response to this rejection in order to expedite prosecution of the present application. However, Applicant reserves the right to file the claims as previously presented in one or more continuation or divisional applications at a future time.

Applicant respectfully submits that the claim language in each of the claims in question, when analyzed in light of the content of the supporting specification, is not indefinite, and meets the requirements of 35 U.S.C. § 112, second paragraph.

For example, with the Final Office Action on page 2 with respect to claims 1 and 26 states, "it is unclear how a device is discovered. It is unclear from where and to where the encoded name is transmitted across a network." In response, claim 1 for example has been amended to recite,

at a server,

discovering a device **attached to the server**;
determining a name associated with the device, wherein the
name is in a first protocol format;
encoding the name into a second protocol format; and
transmitting the encoded name across a network **to a client**.
(Emphasis added).

Applicant respectfully submits that claim 1, as amended, addresses the issues raised in the Final Office Action, and also meets the requirements for definiteness under 35 U.S.C. § 112

second paragraph. Claim 3 depends from claim 1, and therefore includes these amendments to claim 1.

In addition, claim 2 has been amended to recite,

at the client,

receiving the encoded name in the second protocol format
across the network **from the server**;

decoding the encoded name from the second protocol
format into the name in the first protocol format; and

sending the **decoded** name to a host associated with the
client.

(Emphasis added).

Thus, Applicant respectfully submits that claim 2, as amended, addresses the issues raised in the Final Office Action, and also meets the requirements for definiteness under 35 U.S.C. § 112 second paragraph. Further, the amendments to claims 1 and 2 do not require additional search on the part of the Examiner because the amendments to claims 1 and 2 involve the incorporation of subject matter already present in claims 5 and 6 respectively.

Applicant further respectfully submits that claims 18 and 26 include amendments similar to those made with respect to claim 1, and that claims 22 and 27 include amendments similar to those made to claim 2. Therefore, for reasons analogous to those stated above with respect to claims 1 and 2, claims 18, 22, and 26-27 are not indefinite, and meet the requirements for definiteness under 35 U.S.C. § 112 second paragraph.

Claims 7, 10, and 14 have been amended to address the issues raised on page 2 of the Final Office Action with respect to 35 U.S.C. § 112 second paragraph. Applicant respectfully submits that claims 7, 10, and 14 are not indefinite, and meet the requirements for definiteness under 35 U.S.C. § 112 second paragraph.

For at least the reasons stated above, Applicant submits that the 35 U.S.C. § 112 second paragraph rejection of claims 1-3, 7, 10, 14, 18, 22, and 26-27 have been overcome, and respectfully requests withdrawal of the rejection, and reconsideration and allowance of claims 1-3, 7, 10, 14, 18, 22, and 26-27.

§101 Rejection of the Claims

Claims 18-25 were rejected under 35 U.S.C. § 101 because the claimed invention is alleged to be directed to non-statutory subject matter as being an intangible media (e.g., a signal-bearing media) and an abstract idea.

Applicant has amended claims 18-25 to include a "machine-readable medium bearing instructions" and to delete the phrase "signal-bearing media" from each of these claims. Applicant submits that these amendments overcome the 35 U.S.C. § 101 rejection, and so respectfully requests withdrawal of the 35 U.S.C. § 101 rejection, and reconsideration and allowance of claims 18-25.

§103 Rejection of the Claims

Claims 1-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Punj (U.S. Patent No. 5,289,579) in view of Gioquindo et al. (U.S. Patent No. 6,334,154).

The Final Office Action on page 5 states,

Thus, the Office Action clearly established a *prima facie* case of obviousness. Now the burden is shifted to the applicant to rebut it with objective evidence of non-obviousness.

Applicant respectfully disagrees with these statements, and maintains that for at least the reasons stated below, the Final Office Action has *NOT* established a *prima facie* case of obviousness with respect to the 35 U.S.C. § 103(a) rejection of claims 1-31, because the Final Office Action has failed to meet the burden for establishing a *prima facie* case of obviousness for at least the reasons as presented below.

The Final Office Action fails to state a prima facie case of obviousness with respect to claims 1-31 because the Final Office Action fails to show how the proposed combination of Punj and Gioquindo et al. teaches or suggests all of the elements included in claims 1-31.

Obviousness requires that the reference (or references when combined) must teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

It is submitted that Punj is unrelated to the present invention as claimed and that Punj addresses the problem of communicating data over a high speed data network to the desired

terminal device. The paragraph in Punj beginning at column 2, line 46 states “[i]n accordance with the apparatus and method of this invention, an advance is made over the prior art by connecting a channel to a terminal adapter for converting device addressing information to network terminal information and converting the data to be transmitted from channel format into a format suitable for transmission over a high speed data network to the desired terminal device. Arrangements are provided for maintaining in each interface to the network information concerning the state of subchannels connected to the network. In one specific implementation of applicant's invention, the data network is a broadband network, the transmission rate of each of whose facilities is approximately 150 megabits per second in conformance with the CCITT standards for B-ISDN networks and IEEE 802.6 standard for metropolitan area networks. Advantageously, such an arrangement: permits communication at channel rates among all the computers and other devices connected to the data network; removes the distance restriction; permits multiple simultaneous communications to take place; increases the number of end points from 16 to 256; and permits users to change the mapping of subchannel addresses. State information for each subchannel, including availability of a subchannel address, can be transmitted over a B-ISDN or 802.6 network in a sufficiently short time without concern for consuming bandwidth and with low latency. This makes it possible to separate the channels by a distance much greater than the 800 foot limit. Because data moves through a broadband network many times faster than through prior art networks, it is now possible to spend a little extra time to synchronize channels that are widely separated without adversely affecting the time to process a transaction, thus satisfying software and user service levels.” (Emphasis added).

In stark contrast to Punj, claim 1 of the present application includes the limitations of:

discovering a **device attached to the server**;

determining a **name associated with the device**, wherein the name is in a first protocol format;

encoding the name into a second protocol format; and

transmitting the encoded name across a network **to a client**.

It is submitted that the above combination of limitations is neither described nor suggested in Punj or Gioquindo whether taken alone or in combination. Further, the Final Office Action fails to show where in Punj there is a teaching or suggestion of several of the elements included in claims 1-31. For example, the Final Office Action fails to point out where in Punj there is a teaching or suggestion of "determining a **name associated with the device**, wherein the **name is in a first protocol format**" as recited in claim 1. Col 3. line 16 in Punj states "Computer channels are used to communicate between "devices", such as printers, discs, tape units or software systems within a computer." Clearly this does not teach the limitation of "determining a **name associated with the device**, wherein the **name is in a first protocol format**" as claimed in claim 1. The references to "protocol" in the Punj appear to be totally unrelated to the **name of a device** but rather associated with channel information.

In another example, claim 1 includes a recitation of "transmitting the encoded name across a network **to a client**." The Final Office Action fails to point out where "transmitting the encoded name across a network" as recited in claim 1, is taught or suggested in Punj.

In a further example wherein the Final Office Action fails to show in Punj a teaching or suggestion of the claimed subject matter, claim 2 includes,

at the client,

receiving the encoded name in the second protocol format from the server;

decoding the encoded name from the second protocol format into the name in the first protocol format; and

sending the decoded name to a host associated with the client.

(Emphasis added)

The Final Office Action is completely devoid of any statements showing how Punj teaches or suggests these elements as recited in claim 2.

In a still further example, claim 1 recites,

determining a name associated with the device, **wherein**

the name is in a first protocol format;

encoding the name into a **second protocol format**.

(Emphasis added)

In an attempt to supply these elements, for example "a name associated with the device, wherein the name is a first protocol format," the Final Office Action relies on Punj as disclosing "a name associated with the device (e.g., printers, discs, tape units, software systems, etc., col. 3,

line 17)." However, as noted above a recitation of printers, discs, tape units, and software systems is merely a listing of types of devices, and fails to teach or suggest a "name associated with the device" as is recited in claim 1. Further, a recitation of a type of device, such as "printer," fails to disclose "wherein the name **is in a first protocol format**," as is recited in claim 1. (Emphasis added). Still further, the Final Office Action fails to point out in Punj where any of the disclosed types of devices, for example the word "printer," is encoded into a second protocol format. Thus, the Final Office Action fails to show how Punj teaches or suggests any of the elements included in claim 1 as quoted above.

For at least the reasons stated above, the Final Office Action fails to show how Punj teaches or suggests each of the elements included in claims 1 and 2. Applicant's representatives fail to find in, and the Final Office Action fails to point out, where the additional disclosure of Gioquindo et al. teaches or suggests the elements included in claims 1 and 2 and missing from Punj. Because the Final Office Action fails to show where the cited documents of Punj and Gioquindo et al. teach or suggest all of the elements included in each of claims 1-2, the Final Office Action fails to state a *prima facie* case of obviousness with respect to claims 1-2.

For reasons analogous to those stated above with respect to claims 1 and 2, with respect to independent claims 7, 10, 14, 18, 22, and 26, the Final Office Action fails to show how the proposed combination of Punj and Gioquindo et al. teaches or suggests the claimed subject matter included in each of claims 7, 10, 14, 18, 22, and 26, and so the Final Office Action fails to state a *prima facie* case of obviousness with respect to claims 7, 10, 14, 18, 22, and 26.

Claims 2-6, 8-9, 11-13, 15-17, 19-21, 23-25, and 27-31 depend from one of claims 1, 7, 10, 14, 18, 22, and 26, and thus include all of the elements recited in the claim from which they depend. Therefore, the Final Office Action fails to show how the proposed combination of Punj and Gioquindo et al. teaches or suggests all of the claimed subject matter included in claims 2-6, 8-9, 11-13, 15-17, 19-21, 23-25, and 27-31. Thus, the Final Office Action fails to state a *prima facie* case of obviousness with respect to claims 2-6, 8-9, 11-13, 15-17, 19-21, 23-25, and 27-31.

The Final Office Action fails to state a prima facie case of obviousness with respect to claims 1-31 because the Final Office Action fails to provide specific, objective evidence of record for a finding of a teaching, suggestion, or motivation to combine Punj with Gioquindo et al.

The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. The Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

The Final Office Action fails to state a *prima facie* case of obviousness with respect to claims 1-31 because the Final Office Action fails to meet the requirements as stated above for forming the proposed combination of Punj with Gioquindo et al. In an attempt to meet these requirements, the Final Office Action on page 5 merely states,

Such compatible feature of allowing data with different protocol formats to be transmitted among clients and a servers would have been a desirable feature in the art, thus it would have been obvious to one of ordinary skill in the art to combine the teaching of Gioquindo's address resolution protocol into Punj's address conversion (e.g., see the abstract, Figs. 5-7, col. 6 (lines 1-34), col. 10 (lines 6-45)).

Applicant does not agree, and further, submits that a statement that the combination would have been desirable fails to meet the requirements for providing specific, objective evidence of record for a finding of a teaching, suggestion, or motivation to combine Punj with Gioquindo et al. Thus, the statement in the Final Office Action that the proposed combination "would have been a desirable feature in the art" fails to meet the requirements of "providing specific, objective evidence of record for a finding of a teaching, suggestion, or motivation to combine" Punj with Gioquindo et al. It should be noted that both Punj and Gioquindo are totally silent on the conversion of a name associated with a device to different protocols. Thus merely adding the teachings of protocol conversion Punj does not disclose all the limitations of claim 1.

Further, and as noted above, "the fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."¹ While Applicant does not admit that Punj could be combined with Gioquindo et al., the Final Office Action fails to point out how any desirability of the combination of Punj with Gioquindo et al. *is suggested in the prior art*. Without this, the Final Office Action fails to meet the requirements for forming the proposed combination of Punj and Gioquindo et al., and so fails to state a *prima facie* case of obviousness with respect to claims 1-31.

Thus, the statements in the Final Office Action appear to be merely an attempt to reconstruct the claimed subject matter of claims 1-31 using Applicant's disclosure and employing impermissible hindsight, and so fails to meet the requirements as established in the case law and the MPEP as quoted above for stating a *prima facie* case of obviousness with respect to claims 1-31.

Because the Final Office Action fails to show how the proposed combination of Punj and Gioquindo et al. teaches or suggests all of the claimed subject matter included in each of claims 1-31, and because the Final Office Action fails to meet the requirements for making the proposed combination of Punj and Gioquindo et al., the Final Office Action fails to state a *prima facie* case of obviousness with respect to claims 1-31.

For at least the reasons stated above, Applicant respectfully requests withdrawal of the rejections and reconsideration and allowance of claims 1-31.

Reservation of Rights

Applicant does not admit that references cited under 35 U.S.C. §§ 102(a), 102(e), 103/102(a), or 103/102(e) are prior art, and reserves the right to swear behind them at a later date. Arguments presented to distinguish such references should not be construed as admissions that the references are prior art.

¹ *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney 612-371-2132 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

ROGER WOODRUFF

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
612-371-2132

Date JULY 19/2006

By Robert Madden
Robert Madden
Reg. No. 57,521

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JONATHAN FERGUSON

Jonathan Ferguson

Name

Signature